

REMARKS

Claims 18-38 are pending in the application, of which Claims 18, 21, 26, 28, and 31 are independent. Claims have been rejected under 35 U.S.C. 103(a). Applicants respectfully traverse the rejections and request reconsideration.

Finality of the Office Action

Independent Claims 18, 26, and 31 have been rejected in the current Office Action based on new grounds of rejection. The Office states that the new grounds of rejection were necessitated by the amendments of Applicants' previous response. However, independent Claim 31 was not amended and, thus, the new grounds of rejection for Claim 31 was not necessitated by Applicants' amendments, and the Office Action should not have been made final.

Section 706.07(a) of the MPEP states that "second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed [after the mailing of a first Office Action]." Because the new ground of rejection for Claim 31 was not the result of an IDS and was not necessitated by any amendment in Applicants' last response, Applicants respectfully submit that the current Office Action cannot be made final.

That fact that independent Claims 18 and 26 were amended has no bearing on Claim 31 as "a second or any subsequent action ... will not be made final if it includes a rejection, on newly cited art, ... of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art." MPEP section 706.07(a). Therefore, Applicants respectfully request that the finality of the Office Action be withdrawn.

Rejections Under 35 U.S.C. 103(a)

Claims 18, 19, 22-26, 29-32, and 34-38 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Gruber *et al.* (U.S. Patent No. 6,563,795 hereinafter "Gruber") in view of Tsutsui (U.S. Patent No. 5,150,356).

Claims 21 and 28 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Gruber in view of Huey *et al.* (U.S. Patent No. 5,467,349, hereinafter “Huey”).

Claims 20, 27, and 33 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Gruber in view of Tsutsui and further in view of Cappellari *et al.* (U.S. Patent No. 5,557,611, hereinafter “Cappellari”).

The Office acknowledges that the loop back function of Gruber does not disclose originating a call “*in a given direction around the virtual path*” and monitoring for that same call “*to arrive at the source element in the [same] given direction around the virtual path,*” as recited, for example, by independent Claim 18. However, the Office asserts that it would be obvious to modify Gruber with a unidirectional ring (as shown in Fig. 3a of Tsutsui) “to allow OAM cells to travel back to the source node.”

Applicants, however, had anticipated such a proposed modification to Gruber, and explained in their last response that “[e]ven if Gruber’s path were to be arranged in a ring configuration, the loop back functionality of Gruber requires that a trace cell is transmitted back in the opposite direction along Gruber’s path” (emphasis added). Thus, even if Gruber were arranged in a ring, its trace cell would still be sent from one node in one direction in the ring and would be looped back in the opposite direction by another node in the ring. Therefore, it would not have been obvious at the time of Gruber and Tsutsui to modify Gruber’s functionality so as to result in the claimed invention in view of the required loop back functionality.

Further, such a proposed modification is likely the result of hindsight bias based on the teachings of the present application. Disparate pieces of the Gruber and Tsutsui references are being combined with the goal of resulting in the claimed invention, but no real motivation for the proposed combination has been provided. Applicants acknowledge, as stated in section 2142 of the MPEP, that “[t]he tendency to resort to “hindsight” based upon applicant’s disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” Gruber teaches that a trace cell is transmitted back in the opposite direction and does not mention accomplishing this in any other way. Tsutsui discloses a dual-ring configuration, but does not provide any motivation to modify Gruber to transmit a trace cell around a ring, instead of downstream and back upstream as described by Gruber. The only

motivation for such a combination comes from Applicants' own disclosure. As such, Applicants respectfully submit that independent Claims 18, 21, 26, 28, and 31 are novel and nonobvious over the cited art.

Dependent Claims 19, 20, 22-25, 27, 29, 30, and 32-38 each depend from one of the above-mentioned independent claims. Thus, Applicants respectfully submit that those claims are novel and nonobvious over the cited art for at least the same reasons. Therefore, Applicants respectfully request that the rejections under 35 U.S.C. 103(a) be withdrawn and that Claims 18-38 be allowed.

CONCLUSION

In view of the above remarks, it is believed that all currently-pending claims (Claims 18-38) are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned.

Respectfully submitted,

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